



## UNITED STATES DEPARTMENT OF COMMERCE

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08/440,428 05/12/95 DORN

H BAYER-9265-1  
EXAMINER

12M2/0520

ROBINSON, A  
ART UNIT PAPER NUMBERSPRUNG HORN KRAMER & WOODS  
660 WHITE PLAINS ROAD  
4TH FLOOR  
TARRYTOWN NY 10591-51441209  
DATE MAILED:

05/20/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS This application has been examined  Responsive to communication filed on 4-9-96  This action is made final.A shortened statutory period for response to this action is set to expire 3 month(s), 6 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449. (4 sheets)
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

## Part II SUMMARY OF ACTION

1.  Claims 2-5 and 10-14 are pending in the application.  
Of the above, claims 13 and 14 are withdrawn from consideration.
2.  Claims \_\_\_\_\_ have been cancelled.
3.  Claims \_\_\_\_\_ are allowed.
4.  Claims 2-5 and 10-12 are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.
7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8.  Formal drawings are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).
11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).
12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other

## EXAMINER'S ACTION

Art Unit: 1209

As per a restriction requirement made 3/11/96, Applicants elected with traverse (paper number 7) the invention of Group I, claims 2-5 and 10-12 and the specific compound imidoclopid. A limited subgeneric formula supported by the specification containing the elected pyridinylmethyl-imidazolidinium compound would be examined. Applicants' traverse is considered; however, the requirement is deemed proper and adhered to for reasons of record as set forth in paper number 6. Further, the claims read on a multitude of active compounds that are so non-related to each other and so different that they can clearly support separate patents. For example, compare the elected imidoclopid (pyridinylmethyl-imidazolidinium) compound with a 1,3,5-triazine-1,3-thiazole compound; a pyridinyl compound; a pyridinylmethyl-1,3-thiazole compound; a pyrrolidine compound; etc. Therefore, the restriction requirement is deemed proper and adhered to.

Claims 13 and 14 are withdrawn from further consideration as being drawn to a non-elected invention.

Claims 2-5 and 10-12 are acted upon on their merits to the extent that they read on the elected invention.

Claims 3 and 4 are improperly dependent upon more than one claim.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1209

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 2-5 and 10-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Kristiansen et al. (A), Shiokawa et al. (B), Elbert et al. (A†), and Derwent Abstract of JP 03,279,389 (AR").

The prior art teaches that the claim designated pyridinylmethyl-imidazolidinium compounds, analogues, and isomers thereof are known insecticides, effective against insects of the type claimed. The Elbert et al. reference, page 22; the Shinichi et al. reference, col. 4, lines 62-67; and the Kristiansen et al. reference, col. 4, lines 10-23 further teach that the claimed

Serial Number: 08/440,428

-4-

Art Unit: 1209

compounds isomers and analogues thereof are non-toxic to animals, fish, birds, etc. Therefore, one skilled in this art would find ample motivation from the prior art supra to use the claimed compounds as insecticides applied to humans or animals to combat the target insects of the instant application with a reasonable expectation that said compounds would be safe and effective. Thus, no patentable distinction can be seen between the claims of record and the state of the art as taught by the prior art.

References AA, AL, AM, AP, AR, AS, AL', AR'-AT', AS", AT", and AR" are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Robinson whose telephone number is (703) 308-4524. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ALLEN J. ROBINSON  
PRIMARY EXAMINER  
GROUP 1200

ROBINSON:jd  
MAY 17, 1996